



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,114	12/03/2004	Vicau Tang	09669/041001	3129

22511 7590 03/18/2008
OSHA LIANG L.L.P.
1221 MCKINNEY STREET
SUITE 2800
HOUSTON, TX 77010

EXAMINER

PHAM, TUAN

ART UNIT	PAPER NUMBER
----------	--------------

2618

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

03/18/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@oshaliang.com
buta@oshaliang.com

Office Action Summary	Application No. 10/517,114	Applicant(s) TANG ET AL.	
	Examiner TUAN A. PHAM	Art Unit 2618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed on 10/08/2007 have been fully considered but they are not persuasive.

(I) Applicant's First argument:

In response to applicant's remark on pages 6-7, Applicant argues that Examiner has fails to establish a prima facie case of obviousness to combine Johansson in view of Hahn, and Applicant also argues that Hahn fails to teaches automatically content downloading into a communication device via a second network as recited in claims 1, 5, and 7- 8.

In response to applicant's arguments, Examiner respectfully disagrees with the applicant's argument. It appears Applicant is attacking individual merits of Johansson and Hahn and concludes that there is no impetus to combine them. However, the 103 rejection is in consideration the combination of references as a whole. One cannot show non-obviousness by attacking references individually. In re Keller, 208 USPQ 871 (CCPA 1981). The test for obviousness is not whether features of one reference may be bodily incorporated into the other to produce claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in pertinent art. In re Bozek, (CCPA) 163 USPQ 545. The question in a rejection for obviousness on a combination of references is what secondary reference would teach one skilled in the art and not whether its structure could be bodily substituted in basic reference structure. In re Richman, 165 USPQ 509 (CCPA 1970). In this regard, the intent of Hahn as a

secondary teaching is not to combine its structural features into Johansson's structural, but rather to use the teaching of Hahn to combine with teaching of Johansson to meets the claimed invention. Therefore, there is an existing a strong prima facie case of obviousness under 35 U.S.C 103, and proper to combine Johansson and Hahn. Furthermore, Hahn also teaches automatically content downloading into a communication device via a second network (see figure 1, second network WLAN, the mobile phone 7 download the data from the internet via a second network WLAN, [0023]).

(II) Applicant's Second argument:

In response to applicant's remark on page 6, Applicant argues that the claimed invention is directed to management of data and application in a SIM card, the SIM card in a mobile phone automatically begin downloading.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., SIM card in a mobile phone automatically begin downloading) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

For the reasons above, the 103 rejections as set forth in the last Office Action stand.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. **Claims 1-3, and 5-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johansson (Pub. No.: US 2001/0015977) in view of Hahn (Pub. No.: US 2004/0166843).**

Regarding claims 1, 5, 7, and 8, Johansson teaches a communication device, a server, a computer program, and an integrated circuit card being arranged to communicate with a server (see figure 1, SMS-C server 30) via a first communication network (GSM network) and to communicate with the server via a second communication network (GPRS network) wherein the communication device comprises functionality to:

receive a management request instruction from the server via the first communication network (see figure 1, mobile 20 receive SMS from the SMS server 30 via GSM network, [0043-0051]), and

execute the management request instruction (see [0043-0051], the mobile 20 execute an application to extract an activation code) which cause the communication device to request the server to effect an operation in the communication device via the second communication network (see [0043-0051], if the activation code is found, mobile 20 effect a push operation for receiving packet data via the GPRS network from the push server 50).

It should be noticed that Johansson fails to teach automatically content downloading into a communication device via a second network. However, Hahn teaches such features (see figure 1, second network WLAN, the mobile phone 7 download the data from the internet via a second network WLAN, [0023]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Hahn into view of Johansson in order to prevent the data loss when the handover occurs as suggested by Hahn at [0033].

Regarding claims 2 and 6, Johansson further teaches the GSM network and a GPRS network (see figure 1, GSM and GPRS).

Regarding claim 3, Johansson further teaches SMS (see [0045]).

Regarding claims 9-12, Hahn further teaches the first and the second communication networks are wireless communication networks (see figure 1, first wireless network 2, second wireless network 3).

4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johansson (Pub. No.: US 2001/0015977) in view of Hahn (Pub. No.: US 2004/0166843) as applied to claim 1 above, and further in view of Emmerson et al. (U.S. Pub. No.: 2002/0183045, hereinafter, "Emmerson").

Regarding claim 4, Johansson and Hahn, in combination, but fails to disclose security protocol. However, Emmerson teaches such features (see [0044]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Emmerson into view of Johansson and Hahn in order to protect the information downloaded from the network to the wireless device.

Conclusion

5. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 2618

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan A. Pham whose telephone number is (571) 272-8097. The examiner can normally be reached on Monday through Friday, 8:30 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Anderson can be reached on (571) 272-4177. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have question on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit 2618
March 1, 2008
Examiner

/TUAN A PHAM/

Tuan Pham

Application/Control Number: 10/517,114
Art Unit: 2618

Page 8

/Matthew D. Anderson/

Supervisory Patent Examiner, Art Unit 2618